IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Scott C. Harris	Group Art Unit 2157
Appl. No.	:	09/683,599	
Filed	:	January 23, 2002	
For	:	VISUAL DATABASE FOR ONLINE TRANSACTIONS	
Examiner	:	S. Halim	

Reply Brief

Commisioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant herewith files this reply brief under 37 CFR 41.41, thereby responding to the examiner's answer originally mailed on January 8, 2008.

Consider this scenario. You want to buy something, you know it's available on the Internet, and you know what it looks like, but you don't know the word for it. (See Figure 3 of this application) How do you go about finding one? For example, if you want to buy something on eBay, but you don't know its name, how could you find it? Or perhaps you could browse through the listings,

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Scott C Harris 3/10/2008
Scott C Harris March 10, 2008

perhaps you could try to use Google to write whatever you know about the item and see if you can find its name, but none of those are particularly satisfactory solutions. So how do you find that thing where you know what it looks like, but you don't know its name?

The present application recognized this problem, and the claims of this application claim a solution. Admittedly, at the time the present application was filed, image detecting techniques were known; see paragraphs 9-14 of this application, which explains how one could search through image databases. But this was only part of the puzzle. The fact you could search through databases did not make it obvious actually to use that search to find (and according to some claims, purchase) an item on electronic commerce site. That is, until the inventor recognized this problem, no one suggested using database searches of this type 'to find something where you don't know the name for it.

In other words, the recognition of this problem was a large part of the ability to some solve the problem. The patent office has not shown that anyone else recognized this problem, and no one else has suggested any solution to this problem. In fact, the prior art has simply cited a 1) a searching database that searches for items to be purchased in a conventional way as one piece of prior art, and 2) an image database as the other piece of prior art. Clearly, Crill and Hess shows that their teachings were known prior art. However, no one would have been motivated to make their combination, since, quite simply, the motivation for the combination is the recognition of the problem noted above. Without that motivation, there is quite simply no reason to make this combination.

The patent office has taken the position that since these two pieces of the puzzle exist, it would be obvious to combine them. No real reason for the combination has been given, however the patent office has taken the position that it would have been obvious "in no order to allow prospective purchaser to make a more informed decision by providing an improved user interface for online commerce sites". See page 4 of the examiner's answer, first full paragraph. In essence, however, all this is saying is that it would be obvious to combine, because in retrospect, it would make the system better. This reason is circular at best.

This combination is wholly improper. This combination is made only with the basis of hindsight; having had the benefit of applicants understanding of the problem, where the problem itself is a part of the incentive to make the invention.

MPEP 2141.02 subsection 3 is quite clear that discovering the source or cause of the problem can be part of the solution. Quoting *in re Sponnoble*, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969), this section says that "a patentable invention may lie in the discovery of the source of the problem even though the remedy may be obvious once the source of the problem is identified". Here, the problem is quite clearly described within the specification, specifically that you may know what an item looks like, but may not know the name of an item, but still find the item. See specification paragraph 23.

Moreover, applicant is sensitive to the fact that *KSR v. Teleflex*, 550 U.S. ___, 127 S. Ct. 1727 (2007), certainly did change the law of obviousness and when it was obvious to combine prior art references. However, note KSR's

specific language that if something is usable in one field of art "and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way..." then (and apparently only then) it is obvious in another field of art. Summarizing this, the question is " whether the improvement is more than the predictable use of prior art elements according to their established functions". Here, there is no predictability that combining this prior art would produce a special advantage, because there was no recognition of the problem that the combination would solve. Specifically, this combination allows finding items whose name you do not otherwise know.**

Moreover, *KSR* was very clear that it was not overruling any previous case, and by not overruling any previous case, clearly the *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45 (1923) case must stand. In this Supreme Court case, a difference between the invented device and the prior art was the pitch of the paper being fed. The inventor recognized that it was not really needed for that purpose, and that by changing this pitch, it enabled speeding up the process. The court recognized that all Eibel did was raise the pitch of the wire from between 2 and 3 inches to 12 inches, and it enabled greatly increasing the speed. The question was made, however, about whether Eibel's raising the pitch was "a mere obvious application of fully developed devices in the prior art". The Supreme Court found that Eibel had discovered "a source of trouble and the means of remedying it". The fact that all he did was change a few parameters do not defeat patentability. In this context, discovery of the source of the problem was an important part of the patentable invention.

Similarly here, discovery of the source of the problem is part of the patentable invention. Prior to the recognition of this problem, no one had considered doing these things. Hence, quoting *Sponnoble*, "a patentable invention lies in the discovery of the source of the problem even if the remedy is obvious once the source of the problem is identified". If the remedy is obvious at all, it only obvious once one recognizes the problem.

Again, nowhere in the examiner's answer is there one shred of reasoning why one of ordinary skill in the art would combine the primary references. The Examiner's answer states that the combination could be made to allow a prospective purchaser to "make a more informed decision". That is – the reason for the more informed decision? To make a more informed decision. Nowhere is there any teaching suggestion or motivation of anything beyond simply "making a more informed decision ". Virtually every invention is an improvement. Using the rationale set forth in this rejection, virtually everything would be obvious to combine. Clearly, the Supreme Court in *KSR* did not contemplate that everything is obvious to combine.

Applicant will not reiterate the specific arguments for patentability, made completely in the appeal brief. With all due respect, the Patent Office's position on these points is in error and based on hindsight. This hindsight is even more evident when one considers a new argument on page 12 of the examiner's answer, where the rejection states that "anyone who has used eBay knows that price information is available in most search results". Again, this shows

hindsight; it tries to use ebay, which is TODAY's version of ebay, not the prior art, and tries to show information from a text-based search. Quite simply, the prior art does not make obvious the claimed solution.

To summarize, this entire rejection is based on hindsight, is contrary to the law on the subject, and should be reversed.

Respectfully submitted,

Date: _____

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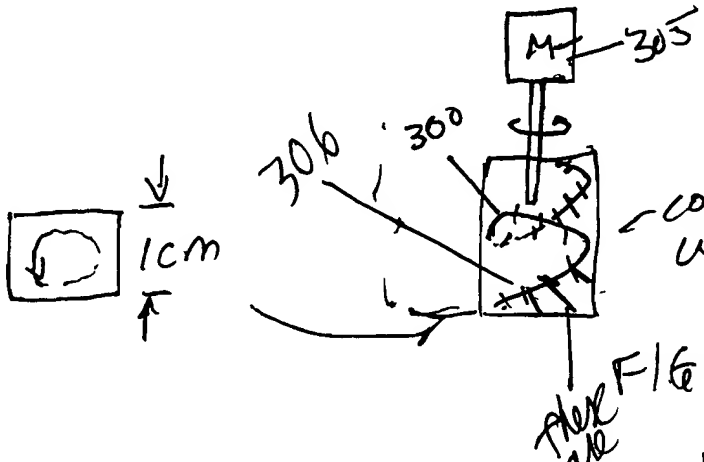


FIG 3

Fan itself uses energy

Duty cycled fan ± is noisy
on for ~1sec
off till heat rebuilds

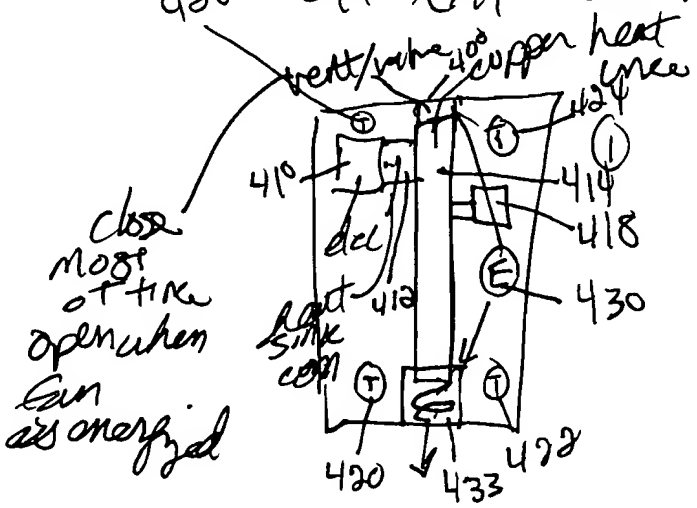
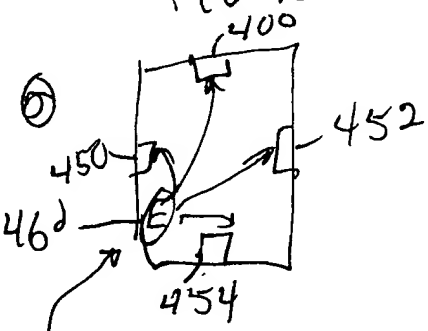
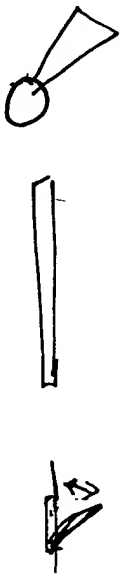


FIG 4A





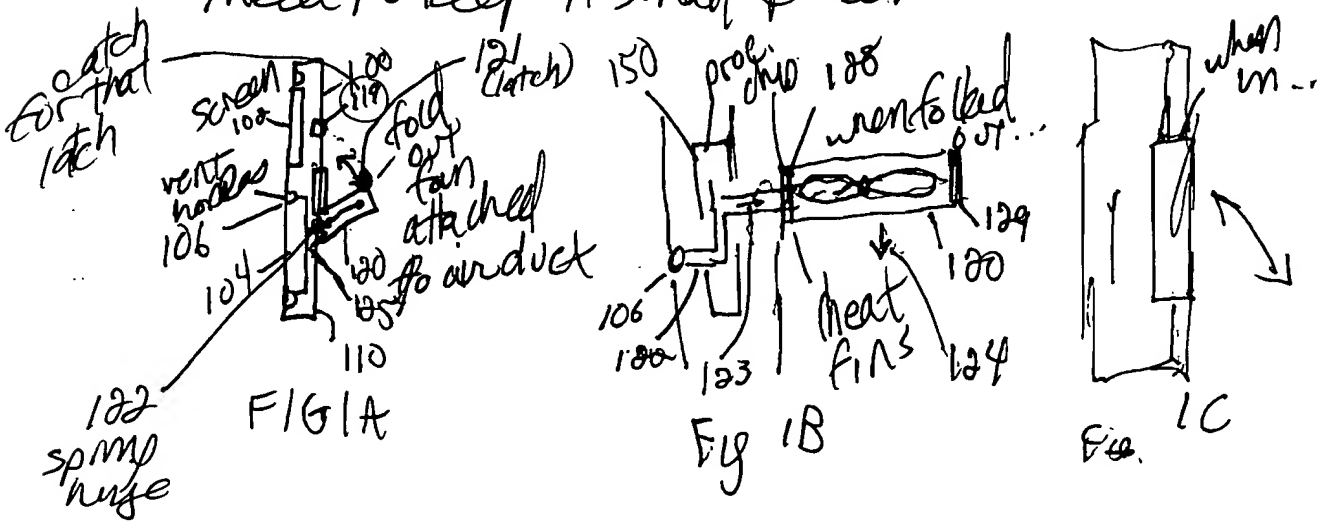
8/5/08

Accessory w/phones do more - but no matter how fast they s/- everything they do comes w/ a heat penalty

- Take/play/edit pic/video
- tx - rcv
- GPS

More you do on phone
1) more power you need
2) more heat you create

Problem -
need to keep it small & stable



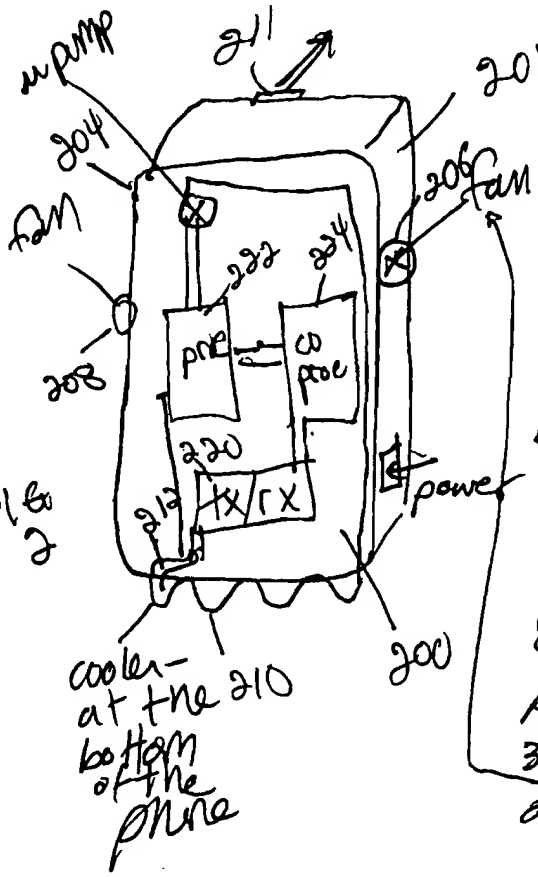
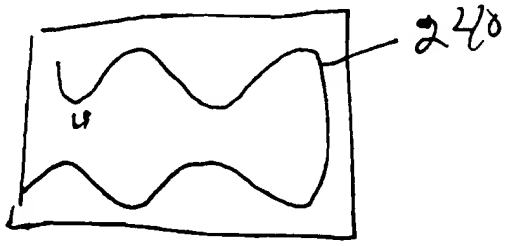


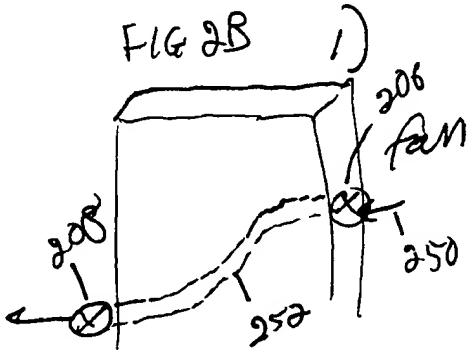
FIG 2

FIG 2A



1) a heat sink surface
2) w/ one or more pull out portions
3) use fans when external power or use more aggressive/aided.

FIG 2B



2)

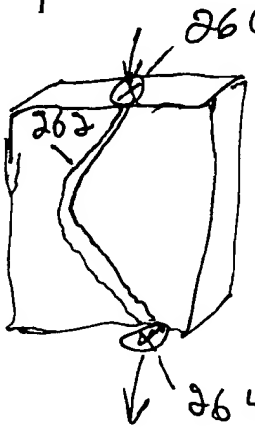


FIG 2C

FIG 2D